REMARKS

In a preliminary matter, claim 1 is amended herein to specify the composition of the second coating layer. These features have a basis in claim 4 as originally filed, for example. Concomitantly, to delete the features which are redundant in light of the present amendments to claim 1, claim 4 is cancelled. Finally, claim 5 is amended to remove its dependency from now-cancelled claim 4.

Accordingly, these amendments have a basis in the specification as filed, and they introduce no new matter into the application. In addition, these amendments are made without prejudice. Applicants intend to reintroduce the subject matter of the claims as originally filed later in the prosecution or in a continuing application.

Turning to substantive issues, Applicants respectfully renew the request under 35 U.S.C. § 132(a) and under 37 C.F.R. §§ 1.104 and 1.113(b) that the nature of the rejection or rejections of the claims be clarified in the record. This request has been presented previously in the Response filed on February 12, 2007, in the second and third full paragraphs of page 7.

More specifically, Applicants first request clarification of the status of the subject matter of original claim 3. (Parenthetically, Applicants note that the scope of claim 3 has been narrowed incidentally to the amendments to claim 1 that are presented herein.) Applicants have previously addressed the status of this subject matter in the Response filed on June 9, 2006, in the fourth full paragraph of page 12, and in the Response filed on February 12, 2007, on page 8. To summarize, however, the Official Action issued on January 9, 2006, rejected claim 3 under 35 U.S.C. § 112 only, and only claims 1, 2 and 4 to 8 were rejected under 35 U.S.C. § 103. The rejection under § 112 was withdrawn in the final Official Action dated October 10, 2006, which also repeated the previously issued rejections (paragraph 5 on page 2) *without adding any further rejections* (paragraph 6 on page 3) and without specifically referring to claim 3 in the response to Applicants' arguments

(paragraph 7 on page 3). Nor has the Advisory Action issued on March 2, 2007, provided any separate discussion of claim 3. Nevertheless, the summary sheets of the final Official Action and the Advisory Action both indicate that claims 1 through 8 have been rejected.

Thus, the continued rejection of this subject matter is improper in light of the statute and regulations cited above. Accordingly, Applicants respectfully request that the specific reasons for the rejection of original claim 3, if any, be identified and supported by the citation of pertinent references. In the alternative, and more preferably, Applicants respectfully request that the allowability of this subject matter be indicated in the record.

Second, Applicants request clarification of the rejection under 35 U.S.C. § 103. Applicants have previously highlighted the ambiguity of this rejection in the Response filed on June 9, 2006, in the third full paragraph of page 13, and in the Response filed on February 12, 2007, in the fifth paragraph on page 6 and in the second and third full paragraphs on page 7. To summarize, however, as the rejection under 35 U.S.C. § 103 was first stated in the Official Action issued on January 9, 2006, in paragraph 8 on page 3, claims 1, 2 and 4 to 8 were rejected as obvious over Kotani in view of Barnes. Plainly, Applicants cannot be expected to confer any meaningful interpretation on the apparent typographical error through which the sentence formulating this rejection ends with the word "and".

In fact, no mention of Harrison appears in the Official Action of January 6, 2006, until the fourth full paragraph of page 5, in which only claim 4 is discussed. In responding to Applicants' arguments, the final Official Action discussed Harrison, but without identifying the claim or claims to which Harrison had been applied (page 3). Moreover, despite Applicants' explicit request, neither the final Official Action nor the Advisory Action identifies the claims that were rejected over Harrison or the references with which Harrison has been combined.

For Applicants, attempting to address the rejection under 35 U.S.C. § 103, as it has been variously and ambiguously iterated in the three Official Actions, and in the absence of the requested clarification, has been analogous to taking aim at a hidden or moving target. Surely, this is not the intended course of any patent prosecution in the U.S. Patent & Trademark Office.

Nevertheless, in yet another effort to further the progress of the present prosecution, Applicants will now proceed under the presumption that it was intended, in the Official Action dated January 9, 2006, to reject claims 1, 2 and 4 to 8 under 35 U.S.C. § 103 as obvious over Kotani, Barnes and Harrison in combination. *Once more, however, for reasons of equity and administrative efficiency, Applicants respectfully request that the accuracy of this presumption be confirmed on the record.*

The rejection under 35 U.S.C. § 103, which was repeated in the final Official Action dated October 10, 2006, and maintained in the Advisory Action issued on March 2, 2007, is the sole substantive reason provided by the U.S. Patent & Trademark Office why claims 1, 2 and 4 to 8 should not be allowed. The facts and reasoning set forth in the previously filed Responses are neither withdrawn nor abandoned. In addition, Applicants respectfully traverse this presumed rejection for the reasons set forth below.

Although Kotani nor Barnes describe anchor layers and primers that may be applied to the substrate before the application of the mineral-containing layer, neither Kotani nor Barnes teaches or suggests a second coating that may be applied over the mineral-containing coatings that they describe. Harrison suggests an "overcoat layer"; however, the composition of this layer is clearly limited to resins that are outside the scope of newly amended claim 1. *See* column 7 at lines 60 to 64, in which it is stated that "the overcoat layer may comprise any suitable film-

forming resin, such as those described herein for use in the primer layer." The resins suitable for use in Harrison's primer layer are identified in column 5 at line 44 to column 6 at line 5. Therefore, Kotani and Barnes and Harrison, taken singly or in combination, do not teach or suggest every element of newly amended claim 1.

For at least these reasons, claim 1 as amended herein is not obvious over Kotani, Barnes and Harrison. Therefore, Applicants respectfully request that the rejection of claim 1 under 35 U.S.C. § 103 be withdrawn upon reconsideration.

Claims 2 and 4 to 8 depend, directly or indirectly, from independent claim 1. It follows by statute that the dependent claims are also not obvious over Kotani, Barnes and Harrison for at least the reasons set forth above with respect to claim 1. Consequently, Applicants respectfully request that the rejections of claims 2 and 4 to 8 under 35 U.S.C. § 103 be withdrawn upon reconsideration.

Conclusion

In an ancillary matter, Applicants have responded fully to the final Official Action. Therefore, it is believed that no reply is outstanding to a rejection under 35 U.S.C. § 132, and accordingly it is also believed that the present response need not comply with the requirements of 37 C.F.R. § 1.111.

A Petition for an Extension of Time for three months and the required fee for the extension are filed concurrently herewith. Should any further fee be required in connection with the present response, the Examiner is authorized to charge such fee, or render any credit, to Deposit Account No. 04-1928 (E.I. du Pont de Nemours and Company).

In view of the above amendments and remarks, it is felt that all claims are in condition for allowance, and such action is earnestly solicited. In closing, the Examiner is invited to contact the undersigned attorney by telephone at (302) 892-1004 to conduct any business that may advance the prosecution of the present application.

Respectfully submitted,

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